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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,032	01/09/2004	Hideo Ikeno	CANO:112	7881
37013 7590 11/25/2008 ROSSI, KIMMS & McDOWELL, LLP. 20609 Gordon Park Square, Suite 150 Ashburn, VA 20147				
EXAMINER				
MEJIA, ANTHONY				
ART UNIT		PAPER NUMBER		
2451				
MAIL DATE		DELIVERY MODE		
11/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/755,032

Applicant(s)

IKENO, HIDEO

Examiner

ANTHONY MEJIA

Art Unit

2451

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 4-8, 12-16 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-11, 17 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. It is hereby acknowledged that claims 4-8, 12-16, and 18 have been withdrawn from further consideration by examiner. Claims 1-3, 9-11, 17 have been amended, and Claims 19-22 have been added, and are all pending along with Claim 8 in the instant application that is now being presented.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Japanese Application No. 2003-005155, filed on 10 January 2003.

Election/Restrictions

3. Upon the consideration of the claimed invention filed on 05 July 2008, it has been determined by the examiner that restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. **Claims 1-3, 9-11, 17, and 19-22**, are drawn to a monitoring apparatus that is capable of acquiring information by communication from at least one image forming apparatus to be monitored and communicating with a management apparatus thru e-mail. The monitoring apparatus processes the e-mail received in the communication from the management apparatus, and automatically updates the first modules that are operating on the

monitoring apparatus with the second modules received in the e-mail from the management apparatus. The monitoring apparatus also collects version information on the first modules when the management apparatus requests such information by e-mail and returns said version information that was collected to the management apparatus by e-mail classified in **class 709, subclass 220**.

- II. **Claims 4-8, 12-16, and 18**, are drawn to a management apparatus that capable of managing a plurality of monitoring apparatuses that acquire information by communication from a plurality of image forming apparatuses to be monitored, the management apparatus sending collective instructions to the monitoring apparatuses to update the first modules on which the monitoring apparatuses operate, to second modules e-mail, and requests for the monitoring apparatuses to acquire version information of the first modules on which the plurality of monitoring apparatuses are operating on and to send this acquired version information back to the said management apparatus classified in **class 709, subclass 224**.

- B. The inventions are distinct, each from the other because of the following reasons:

Art Unit: 2451

4. Inventions I and II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination of Invention I is drawn to the a monitoring apparatus drawn to the combination of:

an e-mail unit configured to *carry out communication with the management apparatus by e-mail*;

a processing unit configured to be *operable when said e-mail unit has received second modules for updating first modules*, on which the monitoring apparatus operates, *from the management apparatus by e-mail, to automatically update the first modules in operation to the second modules*;

an information unit configured to *collect version information on the first modules when said unit has received a version information acquisition request from the management apparatus by e-mail*; and

a returning unit configured to *send the version information collected by said information collecting unit to the management apparatus by return e-mail*.

The subcombination of Invention II has separate utility such as a management apparatus drawn to the combination of:

Art Unit: 2451

an instructing unit configured to *collectively instruct the plurality of monitoring apparatuses to update first modules, on which the plurality of monitoring apparatuses operate, to second modules by e-mail;*

an acquisition requesting unit configured to *collectively give a request for acquisition of version information on the first modules to the plurality of monitoring apparatuses by e-mail; and*

an acquisition unit configured to *acquire the version information from the plurality of monitoring apparatuses as replies to e-mails for requesting acquisition of the version information sent by said acquisition requesting unit.*

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

5. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons

Art Unit: 2451

given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

6. During a telephone conversation with Mr. Lyle Kimms (Reg.No.34, 079) on 11/20/08 a provisional election was made without traverse to prosecute the invention of group I, Claims 1-3, 9-11, 17, and 19-22. Affirmation of this election must be made by applicant in replying to this Office action. As a result of the election, Claims 4-8, 12-16, and 18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b)

Art Unit: 2451

if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Regarding claims 1, 4, 9, and 12, the phrase "capable" renders the claim to be indefinite. It is unclear as to what the phrase "capable" encompasses. Claims 2-3, 5-8, 10-11, 14-16 are also rejected as to at least inheriting the same deficiency through their dependency to Claims 1, 4, 9, and 12. Appropriate correction is required. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an

Art Unit: 2451

application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-3, 9-11, 17, and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Turnbull (US 7,146,412).

Regarding Claim 1, Turnbull teaches a monitoring apparatus (host computer 108) capable of acquiring information by communication from at least one image forming apparatus (computing device 102(2)) to be monitored and communicating with a management apparatus (server 110) (col.4, lines 55-58, col.5, lines 61-67, and col.6, lines 1-2), the monitoring apparatus comprising:

an e-mail unit (e-mail application program) configured to carry out communication with the management apparatus by e-mail (col.5, lines 28-36, and col.7, lines 62-67);

a processing unit (CPU 336) configured to be operable when said e-mail unit has received second modules for updating first modules (current firmware), on which the monitoring apparatus operates, from the management apparatus by e-mail, to automatically update the first modules in operation to the second modules (upgraded firmware) (col.5, lines 36-51, and col.7, lines 62-67);

an information unit (upgrade applet 318) configured to collect version information on the first modules when said unit has received a version information acquisition request from the management apparatus by e-mail (col.7, lines 62-67, and col.8, lines 10-13); and

a returning unit (e-mail application program) configured to send the version information collected by said information collecting unit to the management apparatus by return e-mail (col.5, lines 28-36, col.7, lines 62-67, and col.8, lines 31-38 and 54-64).

Regarding Claim 2, Turnbull teaches a monitoring apparatus according to claim 1, further comprising:

a receiving unit (applet 318) configured to receive an update instruction e-mail containing at least the second modules and an install script (col.7, lines 30-33 and lines 62-67), and an acquisition request e-mail requesting acquisition of the version information indicative of versions of respective ones of the first modules in the monitoring apparatus and a version of the monitoring apparatus as a whole (col.7, lines 60-67, and col.8, lines 10-13),

wherein said processing unit (CPU 336) is configured to activate the install script contained in the update instruction e-mail received by said receiving unit (col.7, lines 30-34, and col.7, lines 60-67), and to update the first modules in operation to the second modules contained in the update instruction e-mail received by said receiving unit, and said information collecting unit is configured to collect the version information in response to the acquisition request e-mail received by said receiving unit (col.8, lines 10-13), and said returning unit is configured to send the version information collected by said information collecting unit to the management apparatus by return e-mail (col.8, lines 31-38, and 54-64).

Regarding Claim 9, Turnbull teaches a control method executed by a monitoring apparatus (host computer 108) capable of acquiring information by communication from at least one image forming apparatus (computing device 102(2)) to be monitored, and communicating with a management apparatus (server 110) (col.4, lines 55-58, col.5, lines 61-67, and col.6, lines 1-2), the method comprising:

- a communication step of carrying out communication with the management apparatus by e-mail (col.5, lines 28-36, and col.7, lines 62-67);

- a processing step of automatically updating first modules (current firmware), on which the monitoring apparatus operates, in operation to second modules (upgraded firmware) for updating the first modules when the second modules is received from the management apparatus by e-mail in said communication step (col.5, lines 36-51, col.7, lines 30-34 and 62-67 and col.8, lines 58-60);

- an information collecting step of collecting version information on the first modules when a version information acquisition request is received from the management apparatus by e-mail in said communication step (col.7, lines 62-67, and col.8, lines 10-13); and

- a returning step of sending the version information collected in said information collecting step to the management apparatus by return mail (col.5, lines 28-36, col.7, lines 62-67, col.8, lines 31-38, and lines 54-64).

Regarding Claim 10, Turnbull teaches a control method according to claim 9 as discussed above. Turnbull further teaches wherein the method further comprises:

a receiving step of receiving an update instruction e-mail containing at least the second modules and an install script, and an acquisition request e-mail requesting acquisition of the version information indicative of versions of respective ones of the modules in the monitoring apparatus and a version of the monitoring apparatus as a whole (col.7, lines 60-67, and col.8, lines 10-13);

wherein said processing step comprises activating the install script contained in the update instruction e-mail received in said receiving step, and updating the first modules in operation to the second modules contained in the update instruction e-mail received in said receiving step, and said information collecting step comprises collecting the version information in response to the acquisition request e-mail received in said receiving step, and said returning step comprises sending the version information collected in said information collecting step to the management apparatus by return e-mail (col.8, lines 31-38, and lines 54-64).

Regarding Claim 17, Turnbull teaches a computer-readable medium storing a computer program for executing a control method implemented by a monitoring apparatus (host computer 108) capable of acquiring information by communication from at least one image forming apparatus (computing device

102(2)) to be monitored, and communicating with a management apparatus (server 110) (col.6, lines 12-17, and lines 39-56), the method comprising:

a communication step of carrying out communication with the management apparatus by e-mail (col.5, lines 28-36, and col.7, lines 62-67);

a processing step of automatically updating first modules (current firmware) on which the monitoring apparatus operates, in operation to second modules for updating the first modules when the second modules (upgraded firmware) for updating the modules is received from the management apparatus by e-mail in said communication step (col.5, lines 36-51, col.7, lines 30-34 and lines 62-67, and col.8, lines 58-60);

an information collecting step of collecting version information on the first modules when a version information acquisition request is received from the management apparatus by e-mail in said communication step (col.7, lines 62-67, and col.8, lines 10-13); and

a returning step of sending the version information collected in said information collecting step to the management apparatus by return mail (col.5, lines 28-36, col.7, lines 62-67, and col.8, lines 31-38 and lines 54-64).

Regarding Claim 19, a monitoring apparatus (host computer 108) capable of acquiring information by communication from at least one image forming apparatus (computing device 102(2)) to be monitored and communicating with a management apparatus (server 110) (col.5, lines 61-67, and col.6, lines 1-2), the monitoring apparatus comprising:

an e-mail unit configured to carry out communication with the management apparatus by email (col.5, lines 28-36 and col.7, lines 62-67);

a processing unit configured to be operable when said e-mail unit has received an update instruction e-mail containing at least second modules for updating first modules, on which the monitoring apparatus operates, and an install script from the management apparatus, to automatically update the first modules in operation to the second modules corresponding to description of the install script (col.5, lines 36-51, col.7, lines 30-33 and lines 62-67);

an information collecting unit configured to collect version information on the first modules when said e-mail unit has received an acquisition request e-mail that requests acquisition of the version information on the first modules from the management apparatus by e-mail (col.7, lines 62-67 and col.8, lines 10-13); and

a returning unit configured to send the version information collected by said information collecting unit to the management apparatus by return e-mail (col.5, lines 28-36, col.7, lines 62-67, col.8, lines 31-38, and lines 54-64),

wherein the install script includes at least one or more commands which are executable in an operating system including said processing unit in the monitoring apparatus (col.7, lines 30-34, and lines 63-67).

Regarding Claim 20, a monitoring apparatus according to claim 19, wherein the acquisition request e-mail requests acquisition of the version information indicative of versions of respective ones of the first modules in the

Art Unit: 2451

monitoring apparatus and a version of the monitoring apparatus as a whole (col.7, lines 60-67, and col.8, lines 10-13).

Regarding Claim 21, Turnbull teaches a control method executed by a monitoring apparatus (host computer 108) capable of acquiring information by communication from at least one image forming apparatus (computing device 102(2)) to be monitored, and communicating with a management apparatus (server 110) (col.5, lines 61-67, and col.6, lines 1-2), the method comprising:

- a communication step of carrying out communication with the management apparatus by email (col.5, lines 28-36 and col.7, lines 62-67);

- a processing step of automatically updating first modules, on which the monitoring apparatus operates, in operation to second modules corresponding to description of the install script when an update instruction e-mail containing at least second modules for updating first modules and an install script are received from the management apparatus in said communication step (col.5, lines 36-51, col.7, lines 30-34 and line 62-67, and col.8, lines 58-60);

- an information collecting step of collecting version information on the first modules when an acquisition request e-mail that requests acquisition of the version information on the first modules from the management apparatus by e-mail in said communication step (col.7, lines 62-67, and col.8, lines 10-13); and

- a returning step of sending the version information collected in said information collecting step to the management apparatus by return e-mail (col.5, lines 28-36, col.8, lines 31-38, and lines 54-64),

Art Unit: 2451

wherein the install script includes at least one or more commands which are executable in an operating system including said processing step in the monitoring apparatus (col.7, lines 30-34, and lines 63-67).

Regarding Claim 22, Turnbull teaches a control method according to claim 21 as discussed above. Turnbull further teaches wherein the acquisition request e-mail requests acquisition of the version information indicative of versions of respective ones of the first modules in the monitoring apparatus and a version of the monitoring apparatus as a whole (col.7, lines 60-67, and col.8, lines 10-13).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Turnbull in further view of Loughran et al (US 2002/0129107) (referred herein after as Loughran).

Regarding Claim 3, Turnbull teaches a monitoring apparatus according to claim 1 as discussed above. Turnbull does not explicitly teach wherein the monitoring apparatus further comprises a decoding unit configured to decode

Art Unit: 2451

contents of an e-mail received by said e-mail unit, and wherein said unit is configured to interpret an instruction from the management apparatus from the contents of the received e-mail decoded by said decoding unit, and to perform processing according to the interpreted contents of the e-mail.

However, Loughran in a similar field of endeavor discloses a method and apparatus for automatic content handling including wherein the monitoring apparatus (email server 10) further comprises a decoding unit (email server 10) configured to decode contents of an e-mail received by said e-mail unit, and wherein said unit is configured to interpret an instruction from the management apparatus from the contents of the received e-mail decoded by said decoding unit, and to perform processing according to the interpreted contents of the e-mail (pars [0009], [0025-0026], [0037], and [0046]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Turnbull with the teachings of Loughran in order to automatically interpret the contents of an e-mail with out user intervention. One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings of Turnbull and Loughran to help make upgrades more accessible and require less effort from the users of the apparatuses (Turnbull: col.1, lines 65-67, and col.2, lines 1-53)

Regarding Claim 11, this control method claim comprises limitation(s) substantially the same, as those discussed on claim 3 above, same rationale of rejection is applicable.

Response to Arguments

14. Applicant's submission of the certified copies of priority documents has been considered, and is sufficient. Therefore, the effective filing date of the above named application is set to 10 January 2003. As a result, the previously made rejection is now moot since the references used in the rejection no longer qualify as a prior art.

15. Clarification to the specification in response to examiner's objection has been considered. The clarification obviates the previously raised objection, as such this specification hereby withdrawn.

Conclusion

Examiner has cited particular paragraphs, columns, and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Art Unit: 2451

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANTHONY MEJIA whose telephone number is (571)270-3630. The examiner can normally be reached on Mon-Thur 9:30AM-8:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mejia, Anthony
Patent Examiner

/Salad Abdullahi/

Primary Examiner, Art Unit 2457